

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BRIAN SHUSTER, ET AL.

Serial No.: 09/893,362

Filed: June 25, 2001

Title: METHOD AND APPARATUS FOR
PROVIDING AUDIO ADVERTISEMENTS IN A
COMPUTER NETWORK

Art Unit: 3622

Examiner: Donald Champagne

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

The appellant filed a Notice of Appeal in the above-identified application on October 24, 2006 under 35 U.S.C. § 134(a), and provides this Appeal Brief under 37 CFR 41.37 (hereinafter "Rule 41.37"). The Appeal Brief meets the substantive requirements of Rule 41.37. The appellant requests entry, consideration, and favorable action on this appeal at the Office's earliest convenience.

In accordance with Rule 41.37(c), the appellant presents the following items under the headings prescribed therein.

Real Party in Interest

Hoshiko, LLC, a Nevada Limited Liability Company, owns the subject application.

Related Appeals and Interferences

None.

Status of Claims

As stated in the Official Action mailed on May 24, 2006 (hereinafter the "Final Action"), claims 1-33 stand rejected. On October 24, 2006, the appellant filed a Notice of Appeal from the rejections of pending Claims 1-33.

Status of Amendments

No claim amendments are currently proposed and none have been denied entry.

Summary of Claimed Subject Matter

This section includes a concise explanation of the subject matter defined in each of the independent claims involved in the appeal (i.e., claims 1 and 17, which includes references to the specification and drawings and other information as specified in Rule 41.37.

Claim 1 defines a method for providing advertising on a computer network. The method comprises the steps of:

(A) "[R]eceiving a request from at least one user for delivery of a user-selected Web page associated with a Web site." Page 8, lines 17-20 and Fig. 2, step 100. See also page 7, lines 3-8. A request is received for a Web page associated with a Web site, such as, for example, when a user selects a link on a Web page.

(B) "[S]electing at least one audio advertisement from a plurality of audio advertisements for delivery to said at least one user in conjunction with said user-

selected Web page." Page 9, lines 13-25 and Fig. 2, step 135. See also page 8, lines 3-6 and page 4, line 27 – page 5, line 2. One or more audio advertisements are selected for delivery with the user-selected Web page. In an embodiment of the invention, these ads may be selected be of interest to the user based on a user profile or other information. The specification makes no mention of visual or audio/visual ads, so the audio advertisement may be an audio-only ad.

(C) "[D]elivering said at least one audio advertisement to said at least one user via said network in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement." Page 3, lines 6-7, Page 4, lines 25-27; page 11, lines 1-14; page 10, lines 20-28. For example, the audio advertisement may be delivered using a hidden frame, i-frame, pop-up window, passive pop-up window, or any other way of creating a connection to a Web browser that is maintained even if the user closes the Web page that originated the connection.

Claim 17 defines a system for providing advertising on a computer network. "A server connected to said computer network and having an audio advertisement application executing in association with said server" is disclosed in the specification at page 5, lines 14-26; page 6, lines 8-11; Fig. 1, items 10, 12. The computer and software function to perform the steps exactly as defined for Claim 1. Accordingly, the explanation of this subject matter is exactly the same as provided above in connection with Claim 1; see above.

Grounds of Rejection To Be Reviewed on Appeal

Claims 1-33 stand rejected under 35 § 103(a) over Hamzy et al. (U.S. Pat. No. 6,636,247) and Net-mercial (PR Newswire, 18 August 1999). This ground of rejection is to be reviewed on appeal. No other grounds for rejection have been set forth.

Argument

In the arguments below, the appellants present reasons why claims 1-33 are separately patentable over the cited references.

MPEP § 2143 states the basic requirements for a *prima facie* case of obviousness under § 103(a) as follows:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Furthermore, a prior art reference must be considered in its entirety, that is, as a whole, including portions that would lead away from the claimed invention. M.P.E.P. §

2141.02; *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448, 230 USPQ 416, 420 (Fed. Cir. 1986). As the Court in *Bausch & Lomb* affirmed, "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Id.*, citing *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965). Among other things, it is improper to combine references without consideration for parts of the references that would have led one of ordinary skill away from the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 296-297, 227 USPQ 657, 669 (Fed. Cir. 1985); M.P.E.P. § 2145(X)D(2). Even if the cited references themselves do not expressly teach away from the invention, the prior art must be considered as a whole, as it would have been viewed by one of ordinary skill in the art. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986).

In general, a rejection for obviousness based on a combination of references must be based on a "thorough and searching" factual inquiry using objective evidence of record. *In re Sang Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). "This precedent has been reinforced in myriad decisions, and cannot be dispensed with." *Id.* "Evidence that supports, rather than negates, patentability must be

fairly considered.” *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ.2d 1529, 1533 (Fed. Cir. 1988).

The present rejections of the claims under 35 U.S.C. § 103(a) are based on references that do not teach or suggest all of the claimed limitations. In addition, the evidence as a whole does not suggest the proposed combinations of prior art references. Instead, the Final Action applies isolated portions of references to reconstruct the invention using hindsight, while ignoring the deficiencies of the references and downplaying one of the reference’s express teaching away from the claimed combination.

Claims 1-33

**HAMZY AND NET-MERCIAL FAIL TO DISCLOSE ALL THE
LIMITATIONS OF INDEPENDENT CLAIMS 1 AND 17.**

Hamzy discloses providing interstitial window advertising, meaning the ad is presented before the requested content is provided. To access the requested content, the user must either interact with the interstitial ad in some fashion, or wait for a timer to expire. Col. 6, line 1 to col. 7, line 26. As acknowledged in the Final Action, Hamzy fails to disclose or suggest providing audio advertising. Although Net-mercial discloses providing audio/visual ads, Net-mercial fails to disclose or suggest:

delivering said at least one audio advertisement to said at least one user via said network in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement

as defined by claims 1 and 17. It is acknowledged in the Background section of the specification for the present application that audio ads were known; however, the method of implementing audio ads in the prior art is criticized. In particular, it is noted in the present application that “[a] need in the industry therefore exists for a way to enable websites to deliver audio advertisements that cannot be bypassed by the visitor.” Page 3, lines 6-7. Net-mercial merely exemplifies such criticized prior art methods of providing audio/visual ads, and fails to disclose or to suggest providing audio ads “in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement,” as defined by claims 1 and 17.

In the Final Action, paragraph 8, it is argued that Net-mercial discloses the “bypass preclusion” elements of claims 1 and 17 in the following text, beginning in the final paragraph of page 1:

Each Net-mercial is displayed inside a window with a black “TV” like frame that draws the user’s eye to the content shown on the screen. A timer informs the user that the ad is only temporary and will expire after a certain number of seconds or when the Web site loads. The user can choose, through a series of button bars on the frame to play, pause, request more information, print or exit the ad or wait while the requested site continues to load.

Reading this and other portions of Net-mercial in their entirety shows that the argument in the Final Action -- that Net-mercial discloses bypass preclusion -- must fail. Net-mercial specifically teaches that the user *is not precluded from* bypassing playback of the audio advertisement: “[t]he user can . . . play, pause, request more information, print or *exit* the ad.” Teaching therefore that the consumer can exit the ad, Net-mercial

necessarily fails to disclose providing the ad in a format that precludes the user from bypassing the ad. These two concepts are mutually exclusive. Because the user can exit the ad, the user is not precluded from bypassing any portion of the ad.

This deficiency in Net-mercial is consistent with its teaching that the user is given "complete control of the ad:"

Net-mercials are a simple but highly technical transitional Web advertising solution that occupies the interstitial and intrastitial spaces that occur as a Web site or Web page loads. Each ad maximizes the use of an Internet space and time that is currently void of any consumer experience. Net-mercials currently load in under three seconds, *while giving the consumer complete control of the ad.*

Page 1, second full paragraph (emphasis added). This teaching reinforces the deficiency of Net-mercial. The concept that the consumer is given complete control of the ad likewise necessarily contradicts the requirement of claims 1 and 17 that the ad be provided in a format that precludes the user from bypassing any portion of the ad. Clearly, if the user is given complete control of the ad, she cannot be precluded from bypassing any portion of it. Accordingly, the combination of Hamzy and Net-mercial fails to disclose or suggest precluding bypass of a played audio ad, as defined by claims 1 and 17.

Nor is any suggestion or motivation to remedy this deficiency apparent, except in the disclosure of the instant application. Net-mercial discloses "display" of an interstitial or intrastitial ad, which may or may not have an audio component. In contrast, claims 1 and 17 define only an "audio advertisement." The specification includes descriptions of

embodiments in which an audio-only ad is delivered, meaning there need be no visible component. In fact, the specification does not mention the use of visible or visual advertising at all. Like a radio ad, the audio ad may play while a user is viewing other content on the user computer, and therefore need not be limited to interstitial or intrastitial spaces between Web pages, or otherwise delay access to requested content.

In contrast, both Hamzy and Net-mercial are concerned with visible interstitial advertising. In a visible media such as the World-Wide Web, visible advertising interrupts or displaces other visual content. As noted above, Net-mercial specifically teaches that bypass should not be precluded. At the same time, Hamzy is not concerned with playback at all, but only with static display of interstitial ads. At most, Hamzy merely discloses that an interstitial static Web page may be displayed for a predetermined time period while preventing access to the requested content. Col. 2:25-29. Hamzy therefore suggests nothing about precluding bypass of played audio advertising, while for its part, Net-mercial discloses providing the user with the option to exit played ads at any time. Therefore, considering these two references as a whole, together with the fact that both concern visual advertising, no basis has been provided for remedying their deficiencies with respect to bypass preclusion of audio ads, including audio-only ads.

In summary, the combination of Hamzy and Net-mercial fails to disclose every element of claims 1 and 17, as is required to support a *prima facie* case of obviousness

under 35 U.S.C. § 103(a). These claims are therefore allowable. Claims 2-16 and 18-33 are also allowable, at least as depending from allowable base claims. These rejections should therefore be withdrawn.

Conclusion

Appellants respectfully request the reversal of the rejection of currently pending Claims 1-33, and allowance of these claims forthwith, for the reasons set forth above.

Appendix

Appealed Claims 1-33 are attached hereto as Appendix A. Evidence for consideration in this appeal is attached hereto as Appendix B. Related Appeals and Interferences, if any, are listed in Appendix C.

Respectfully submitted,

Date: December 26, 2006


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APPENDIX A

APPEALED CLAIMS

1. (Previously presented) A method for providing advertising in a computer network, comprising:

receiving a request from at least one user for delivery of a user-selected Web page associated with a Web site;

selecting at least one audio advertisement from a plurality of audio advertisements for delivery to said at least one user in conjunction with said user-selected Web page; and

delivering said at least one audio advertisement to said at least one user via said network in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement.

2. (Original) The method of Claim 1, further comprising delivering software code to said at least one user that enables said user to link to another Web site during delivery of said audio advertisement.

3. (Original) The method of Claim 2, further comprising enabling said at least one user to use any of a plurality of input devices to signal a desire to link to said other Web site.

4. (Original) The method of Claim 1, further comprising cross-promoting participating Web sites within said computer network.

5. (Original) The method of Claim 1, further comprising compensating an advertiser according to a total number of said audio advertisements delivered to said at least one user.

6. (Previously presented) The method of Claim 5, further comprising providing credits to said advertiser for delivery of said audio advertisements.

7. (Previously presented) The method of Claim 7, further comprising permitting exchange of said credits for delivery of other audio advertisements.

8. (Original) The method of Claim 1, further comprising maintaining a database of tendency data corresponding to said at least one user.

9. (Original) The method of Claim 8, further comprising weighting said tendency data in accordance with predetermined criteria.

10. (Original) The method of Claim 8, further comprising generating query strings according to said tendency data stored within said database.

11. (Original) The method of Claim 10, further comprising generating secondary query strings utilizing a query string database in conjunction with said tendency data.

12. (Original) The method of Claim 10, wherein said selecting step further comprises selecting one of said plurality of audio advertisements for said at least one user in accordance with said tendency data.

13. (Original) The method of Claim 1, wherein said delivering step further comprises downloading said at least one audio advertisement onto a computer operated by said at least one user.

14. (Original) The method of Claim 13, wherein downloading step further comprises downloading said at least one audio advertisement concurrently with downloading of other types of data onto said computer.

15. (Original) The method of Claim 13, wherein said downloading step is completed regardless of whether said at least one user has left said user-selected Web page.

16. (Original) The method of Claim 1, wherein said delivering step further comprises determining if a sufficient amount of said at least one audio advertisement has been delivered as to begin playing of said at least one audio advertisement.

17. (Previously presented) A system for providing advertisements in a computer network, comprising:

a server connected to said computer network and having an audio advertisement application executing in association with said server to provide the functions of:

receiving a request from at least one user for delivery of a user-selected Web page associated with a Web site;

selecting at least one audio advertisement from a plurality of audio advertisements for delivery to said at least one user in conjunction with said user-selected Web page; and

delivering said at least one audio advertisement to said at least one user via said network in a format that precludes said at least one user from bypassing playback of any portion of said audio advertisement.

18. (Original) The system of Claim 17, wherein said application further comprises the function of delivering software code to said at least one user that enables said user to link to another Web site during delivery of said audio advertisement.

19. (Original) The system of Claim 18, wherein said application further comprises the function of enabling said at least one user to use any of a plurality of input devices to signal a desire to link to said other Web site.

20. (Original) The system of Claim 17, wherein said application further comprises the function of cross-promoting participating Web sites within said computer network.

21. (Original) The system of Claim 17, wherein said application further comprises the function of compensating an advertiser according to a total number of said audio advertisements delivered to said at least one user.

22. (Original) The system of Claim 21, wherein said application further comprises the function of providing credits to said advertiser for delivery of said audio advertisements.

23. (Original) The system of Claim 22, wherein said application further comprises the function of permitting exchange of said credits for delivery of other audio advertisements.

24. (Original) The system of Claim 18, further comprising a database of tendency data corresponding to said at least one user.

25. (Original) The system of Claim 24, wherein said application further comprises the function of weighting said tendency data in accordance with predetermined criteria.

26. (Original) The system of Claim 24, wherein said application further comprises the function of generating query strings according to said tendency data.

27. (Original) The system of Claim 26, wherein said application further comprises the function of generating secondary query strings utilizing a query string database in conjunction with said tendency data.

28. (Original) The system of Claim 24, wherein said selecting function further comprises selecting one of said plurality of audio advertisements for said at least one user in accordance with said tendency data.

29. (Original) The system of Claim 18, wherein said delivering function further comprises downloading said at least one audio advertisement onto a computer operated by said at least one user.

30. (Original) The system of Claim 29, wherein downloading function further comprises downloading said at least one audio advertisement concurrently with downloading of other types of data onto said computer.

31. (Original) The system of Claim 18, wherein said downloading function is completed regardless of whether said at least one user has left said user-selected Web page.

32. (Original) The system of Claim 18, wherein said delivering function further comprises determining if a sufficient amount of said at least one audio advertisement has been delivered as to begin playing of said at least one audio advertisement.

33. (Previously presented) The method of Claim 13, wherein said downloading step further comprises initiating the download using at least one object selected from a hidden frame, an i-frame, a pop-up window, and a passive pop-up window, whereby said object maintains a connection to said computer even if said at least one user leaves said user-selected Web page.

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APPENDIX B

EVIDENCE

NONE.

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APPENDIX C

RELATED APPEALS AND INTERFERENCES

NONE.